

REMARKS

Applicants appreciate the careful consideration provided by the Examiner in the Office Action dated April 14, 2008. By this submission, claims 1 and 9 are amended. Claims 1, 2, 4, and 6-11 are therefore currently pending.

Prior Art Rejections

Claims 1, 2, 6, 7 and 9-11 stand rejected under 35 U.S.C. §102(e) as being anticipated by Nishitani et al, U.S. Patent 5,966,553 (hereinafter "Nishitani"). Claims 4 and 8 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Nishitani in view of Hanzawa, U.S. Patent 5,506,661 (hereinafter "Hanzawa").

In the final Office Action, the rejection asserts as to claim 1, that Nishitani teaches the features in the claim including ...displaying digital image data with no printing-specifying information onto said displaying means, such that said digital image data for which said printing-specifying information was set and said digital image data with no printing-specifying information are discriminated from each other when they are displayed on said displaying means. The rejection asserts that the camera of Nishitani has a standard LCD monitor 12 which is used as a standard view finder to display an image before the photo is taken and the image is captured, and that before the image is captured the image is displayed without print option data. Therefore the Office Action alleges that the camera of Nishitani meets the limitation that the camera displays information with printing-specifying information and with no printing-specifying information as claimed.

While not conceding the appropriateness of the rejection, but merely to advance the prosecution of the instant application, Applicants respectfully submit that independent claim 1 has been amended in a manner to make clear that the display means displays digital image data of a photographed image, the digital image data having been acquired by photographing and stored as fixed image data in a storage medium; and that said digital image data for which said printing-specifying information was set and said digital image data with no printing-specifying information are discriminated from each other when they are displayed at the same time on said displaying means. Claim 9 has been amended to make clear that both the image for which

printing-specifying information was set as well as the image without printing-specifying information are the images displayed that have been acquired by photographing and stored as a fixed image. Clearly, Nishitani fails to show or suggest these features as now claimed.

Legal Standard for Anticipation and Obviousness Rejections

According to MPEP §2131, "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. Of California, 814 F.2d 628, 631, 2 USPQ2d 1051 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ...claims." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913 (Fed. Cir. 1989). As to claims 1 and 9, Applicants respectfully submit that the prior art as applied in the Office Action fails to establish the required *prima facie* case of anticipation because the cited reference, Nishitani, fails to teach or suggest each and every feature as set forth in the claimed invention, as now amended. Applicants submit that claims 1 and 9 are allowable for at least this reason.

As to each of dependent claims 2, 6-7, and 10-11, these claims are submitted to be allowable for at least the reasons set forth above regarding their corresponding independent claims, and/or for the further features claimed therein.

Similar to anticipation rejections, in order to establish a *prima facie* case of obviousness, the prior art references must teach or suggest all the claim limitations. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). As to claims 4 and 8, rejected under 35 U.S.C. §103(a), Hanzawa does not supply the missing features of claim 1 that are lacking from Nishitani. Moreover, it is not clear how one might combine the disclosures of Nishitani and Hanzawa since Hanzawa is not directed to a digital camera at all, but is instead directed to the display for a mimeographic printing apparatus. Such an apparatus cannot display a digital photograph at all and can only display print control parameters. The rejection is silent as to what would create a nexus that would connect such disparate prior arts. Claims 4 and 8 are additionally submitted to

be allowable for the reasons set forth above regarding claim 1, and/or for the further features claimed therein.

Conclusion

All objections and rejections raised in the Office Action having been properly traversed and addressed, it is respectfully submitted that the present application is in condition for allowance. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance. Notice of same is earnestly solicited.

Prompt and favorable consideration of this Amendment is respectfully requested.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Paul T. Sewell, Registration No. 61,784, at (703) 205-8000, in the Washington, D.C. area.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.14; particularly, extension of time fees.

Dated: July 11, 2008

Respectfully submitted,

By 

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